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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,919	11/17/2003	Kevin G. O'Brien	RB-43884	4237

22242 7590 08/28/2006

FITCH EVEN TABIN AND FLANNERY  
120 SOUTH LA SALLE STREET  
SUITE 1600  
CHICAGO, IL 60603-3406

EXAMINER
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ELOSHWAY, NIKI MARINA

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/715,919

Applicant(s)

O'BRIEN ET AL.

Examiner

Niki M. Eloshway

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 May 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-44 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 21-23, 25 and 26 is/are allowed.  
6) ☒ Claim(s) 1-20, 24 and 27-44 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 10, 13-17, 20, 24 and 29-32 are rejected under 35 U.S.C. 102(b) as being anticipated by King (U.S. 6,264,056). King teaches a first housing 2, having at least one wall 3-6, a knockout at 16 and extension at 22. Regarding claims 20 and 24, the knockouts are elements 16, the knockout coupler is considered to be element 17 and the wall coupler is considered to be slots 23.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over King (U.S. 6,264,056) in view of Davis (U.S. 4,294,371). King teaches a first housing 2, having at least one wall 3-6, a first housing edge surface 15, and outer first housing ridge 40. King discloses the claimed invention except for the inner first housing ridge. Davis teaches that it is known to provide a container with an inner first housing ridge (see element 32). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the housing of King with the inner first housing ridge of Davis, in order to better prevent lateral movement of one housing with respect to another.

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5. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over King in view of Davis, as applied to claim 1 above, and further in view of Girotti et al. (U.S. 4,014,450). The modified housing of Davis discloses the claimed invention except for the second inner and outer first housing ridges.

Girotti et al. teaches that it is known to provide a housing with multiple inner and outer first housing ridges. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified housing of King with multiple inner and outer first housing ridges, as taught by Girotti et al. in order to provide a better interlock between two housings.

6. Claims 11, 12, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over King in view of Slater et al. (U.S. 4,389,535). King discloses the claimed invention except for the relative thicknesses of the knockout, wall portion and extension. Slater et al. teaches that it is known to provide a knockout with a thickness which is less than the thickness of the wall portion and extension. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the housing of King with the knockout having a thickness which is less than the thickness of the wall portion and extension, as taught by Slater et al., in order to allow the knockout to be easily removed without inadvertently damaging the wall or extension.

7. Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over King in view of Giggard et al. (U.S. 4,676,392). King discloses the claimed invention except for the gap. Giggard et al. teaches that it is known to provide a gap in a container for the insertion of the prying tool (see element 114 and col. 6 lines 21-56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the housing of King with a gap as taught by Giggard et al., in order to easily remove the lid using a prying tool.

8. Claims 35, 36 and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallagher et al. (U.S. 6,362,419) in view of Olson et al. (U.S. 6,460,563) and King. Gallagher et al. discloses the claimed invention except for the lid being planar and except for the knockout. Olson et al.

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teaches that it is known to provide a lid with a planar shape. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lid of Gallagher et al. with the planar shape taught by Olson et al., in order to reduce the capacity of the housing.

King teaches that it is known to provide a lid with a knockout (see figure 5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified lid of Gallagher et al. with a knockout, as taught by King, in order to permit access to the cavity from above.

9. Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallagher et al. (U.S. 6,362,419) in view of Olson et al. (U.S. 6,460,563) and King, as applied to claim 35 above, and further in view of Slater et al. (U.S. 4,389,535). The modified lid of Gallagher et al. discloses the claimed invention except for the relative thicknesses of the knockout, wall portion and extension. Slater et al. teaches that it is known to provide a knockout with a thickness which is less than the thickness of the wall portion and extension. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified lid of Gallagher et al. with the knockout having a thickness which is less than the thickness of the wall portion and extension, as taught by Slater et al., in order to allow the knockout to be easily removed without inadvertently damaging the lid.

10. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gallagher et al. (U.S. 6,362,419) in view of Olson et al. (U.S. 6,460,563) and King. Gallagher et al. discloses the claimed invention except for the lid being generally planar shaped. Olson et al. teaches that it is known to provide a lid with a planar shape. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lid of Gallagher et al. with a generally planar shape, as taught by Olson et al., in order to reduce the capacity of the housing.

***Allowable Subject Matter***

11. Claims 21-23 and 25-28 are allowed.

***Response to Arguments***

12. Applicant's arguments filed May 25, 2006 have been fully considered but they are not persuasive. Regarding claims 10 and 13-16, Applicant argues that the extensions of King do not meet the limitation that the extensions extend onto either the inner face or the outer face of the knockout. It is the examiner's position that although the King extensions differ from the extension of the present invention, the claim language does not define the extensions of the present invention over the extensions of King. Claim 10 recites that the extensions extend from the wall onto one of the inner face and the outer face of the knockout. The King extensions extend laterally from the inner surface and the outer surface to connect the knockout to the wall. Regarding the argument that the extensions of King do not remain on the knockout after removal, it is noted that this features is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
13. Regarding claims 20, 24 and 29, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. The tabs 17 of King could fit into the grooves 23 once the knockout is removed, leaving a portion of the knockout covering the opening.
14. Applicant argues that King does not teach a fulcrum that can support a lever to lift off a lid, as recited in claims 30-32. The examiner disagrees with this position. The lip 40 of the King housing would act as a fulcrum for a lever which is inserted between the wall and the lid. Particularly in the area of the grooves 23 where the edge surfaces of the housing are uneven.

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15. Regarding claims 1-6 and 9, Applicant argues that since the halves of the King housing are permanently bonded, there is no motivation to have an outer housing ridge to prevent movement. The examiner disagrees with this position. There is a need to prevent lateral movement of one housing with respect to the other before the adhesive is allowed to cure.

16. Applicant's arguments with respect to Ovadia et al. have been considered but are moot in view of the new ground(s) of rejection. The new grounds of rejection over the secondary reference of Girotti et al., were necessitated by the amendment filed May 25, 2006.

17. Regarding claims 11, 12, 18 and 19, Applicant argues that Slater does not disclose that the knockout has a thickness that is less than the thickness of the wall portion and the extension. The examiner disagrees with this position. Figures 8, 10, 22 and 23 of Slater et al. show embodiments where the knockout has a thickness that is less than the thickness of the wall portion and extension.

18. Applicant's arguments with respect to Kobilan have been considered but are moot in view of the new ground(s) of rejection. The new grounds of rejection over the secondary reference of Giggard et al., were necessitated by the amendment filed May 25, 2006.

19. Regarding claims 35, 36, 40-44, the capacity of the lid of Gallagher can be reduced depending on the amount of contents. Gallagher teaches that connections are made in the top half. It is the examiner's position that reducing the height of the lid of Gallagher would not effect it's ability to make connections. The Gallagher lid would have a "generally planar shape" while still being able to make connections when the height is reduced.

### ***Conclusion***

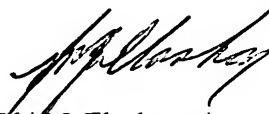
20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niki M. Eloshway whose telephone number is 571-272-4538. The examiner can normally be reached on Thursdays and Fridays 8 a.m. to 4 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Niki M. Eloshway/nme  
Patent Examiner  
August 18, 2006



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